



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/450,923	11/29/1999	JIMMY PIN FAI CHUI	11087/016001	8332

7590 01/15/2003

FISH & RICHARDSON PC
2200 SAND HILL ROAD
SUITE 100
MENLO PARK, CA 94025

EXAMINER

MATHEWS, ALAN A

ART UNIT

PAPER NUMBER

2851

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/450,923

Applicant(s)

CHUI ET AL.

Examiner

Alan A. Mathews

Art Unit

2851

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2002 and 12 August 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: On page 1, line 3, Applicant is required to provide the serial number of the provisional application which is currently left blank. In addition, Applicant states on page 1, lines 1 and 2, that Priority is claimed from serial number 09/428,871. But Applicant has not recited the type of relationship the instant application has with serial number 09/428,871. Is it a continuation-in-part, a divisional, or a continuation? If the instant application contains subject matter not included in serial number 09/428,871, then the instant application cannot be a divisional or a continuation. The instant Application may be a continuation-in-part of serial number 09/428,871, or serial number 09/428,871 may simply be a related application to the instant application for which no priority is claimed. Appropriate correction is required.

Claim Objections

2. The claims are objected to in that the faxed amendment received July 23, 2002, did not include all the claims in the clean copy of the claims. Some of the clean copy of the claims are missing. The faxed copy of the marked-up claims received July 24, 2002, did include all the claims. The Examiner is using the complete set of claims in the marked-up version to examine

Art Unit: 2851

the claims. Any response to this office action must include a complete clean copy of all the claims currently in this application.

Terminal Disclaimer

3. The terminal disclaimer filed on August 12, 2002 has been reviewed and is NOT accepted. The assignee has not established its ownership interest in the application, in order to support the terminal disclaimer. There is no submission in the record establishing the ownership interest by either (a) providing documentary evidence of a chain of title from the original inventor(s) to the assignee, or (b) specifying (by reel and frame number) where such documentary evidence is recorded in the Office (37 CFR 3.73(b)).

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2851

5. Claims 1-70 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-155 of copending Application No. 09/436,704. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-70 in the instant application are obvious modifications of claims 1-155 in copending Application No. 09/436,704.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

6. Claims 23, 24, 34, 37-39, 56, and 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 23, 24, 56, and 57, there is no antecedent basis for "the parameters" on line 1 of each claim. Claim 34 depends on claim 32. Claim 32 recites on lines 3-5, "each identifier ----identifying ----one or more printing parameters associated with the photographic print." But claim 34 recites "wherein the identifier further identifies one or more printing parameters associated with the photographic print". Thus, claim 34 appears to recite redundant language that is already recited in claim 32. Claims 37 and 38 each depend on claim 35, which depends on claim 33, and claim 33 depends on claim 32. Claim 39 depends on claim 38. The dependency of claim 37 is 37/35/33/32. But claim 37 recites exactly the same language that claim 33 recites. Therefore, claim 37 recites redundant language

Art Unit: 2851

that is already recited in claim 33. With respect to claim 38, the dependency of claim 38 is 38/35/33/32. Claim 32 recites on lines 3-5, "each identifier ----identifying ----one or more printing parameters associated with the photographic print." Claim 38 recites "wherein the identifier further identifies one or more printing parameters associated with the photographic print". Thus, claim 38 appears to recite redundant language that is already recited in claim 32. With respect to claim 39, the dependency of claim 39 is 39/38/35/33/32. But claim 39 recites exactly the same language as claim 35. Therefore, claim 39 recited redundant language which is already recited in claim 35.

Claim Rejections - 35 USC § 103

7. Claims 1, 5-10, 32-43, 48, and 52-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slater et al. (U. S. Patent No. 6,157,435) in view of Hicks (U. S. Patent No. 5,359,387). Slater et al. discloses in figures 5 and 8 and column 15, lines 14-67, and columns 16 and 17, a method of facilitating photographic print re-ordering including a print (or certificate) 500, which includes images 501 and 510. Column 15, lines 65-67, and column 17, lines 1-3, state that the print (certificate) is provided with codes 504 and 505 and unique identifiers 511 and 512 (i.e. each identifier being unique to one of the photographic prints). Column 16, lines 31-36 disclose providing the **parameters** for the algorithm used to modify image 501. These would be one or more printing parameters. Column 15, lines 16-35, also discloses altering in some manner the image captured by the customer, such as **zoomed, cropped** --- and the like. Again, these are printing parameters. Column 17, lines 4 - 6 state that based on code 511 or 512, the digital

Art Unit: 2851

image signals (**including any necessary image processing**) are generated for the product and /or service as indicated by code 504. **It is also noted that one could scan multiple rolls of film in Slater et al., and as a result, have multiple certificates 500 (or prints 500).** Thus, Slater et al. discloses the invention except for specifically stating that the identifier identifies a recipient of the photographic print. But the customer (or originator) could be the recipient of the photographic print, and it would be obvious that the certificate would want to identify the customer. It is further well known that certificates for purchasing items often identify the customer. Hicks discloses in figure 2, and on lines 6 and 7 of the Abstract, and in column 3, lines 24-26, forming a combined print and order form 14. Column 3, lines 15 and 16 disclose providing an identifying group code or name for the purpose of better control of the order form at the printers. The group code or name is the recipient. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide Slater et al. an identifier identifying a recipients of the photographic print in view of either Hicks or in view of the old and well known concept of certificates listing the recipients of the merchandise for the purpose of making the photofinisher's task easier. With respect to claim 48, the last line of the Abstract in Slater et al. discloses that a computer program product can execute such a method.

8. Claims 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slater et al. (U. S. Patent No. 6,157,435) in view of Sheridan (U. S. Patent No. 5,760,917) and in further view of Hicks (U. S. Patent No. 5,359,387). Slater et al. discloses receiving an order to send a plurality of photographic prints to a recipient. Slater et al. could scan a plurality of rolls of film from the same customer (originator), and thus produce a plurality of certificates 500 (or a

Art Unit: 2851

plurality of prints 500). Slater et al. discloses in column 15, lines 64-67, encoding the certificates (or prints) with a number that includes a unique identification of the customer order (in particular, a unique identification of customer image 501), which prompted generation of that certificate. Such indication is provided in both machine readable bar code 511 and corresponding human readable characters in the form of visually readable alphanumeric code 512. Thus, Slater et al. discloses the invention except for specifically disclosing a plurality of recipients. Sheridan discloses in figure 2 and column 4, lines 48-67, the desire to share image sets with a plurality of recipients for the well known purpose of increasing the pleasure of viewing the images among friends and relatives or increasing the efficiency of distribution if images in a business environment. Hicks discloses in figure 2, and on lines 6 and 7 of the Abstract, and in column 3, lines 24-26, forming a combined print and order form 14. Column 3, lines 15 and 16 disclose providing an identifying group code or name for the purpose of better control of the order form at the printers. The group code or name is the recipient. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have the order in Slater et al. designate a plurality of recipients in view of Sheridan for the well known purpose of increasing the pleasure of viewing the images among friends and relatives or increasing the efficiency of distribution if images in a business environment. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide Slater et al. with a reorder number specific to the intended recipients in view of Hicks for the purpose of better control of the order form at the printers.

Art Unit: 2851

9. Claims 62 –64, 69, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slater et al. (U. S. Patent No. 6,157,435) in view of Sheridan (U. S. Patent No. 5,760,917).

Slater et al. discloses in figures 5 and 8 and column 15, lines 14-67, and columns 16 and 17, a method of facilitating photographic print re-ordering including a print (or certificate) 500, which includes images 501 and 510. Column 15, lines 65-67, and column 17, lines 1-3, state that the print (certificate) is provided with codes 504 and 505 and unique identifiers 511 and 512 (i.e. each identifier being unique to one of the photographic prints). Column 16, lines 31-36 disclose providing the **parameters** for the algorithm used to modify image 501. These would be one or more printing parameters. Column 16, lines 31-36 states:

Alternatively, but less preferably, codes 505, 504 could themselves contain the instructions for a product or service and at least parameters for the algorithm used to modify image 501.

Thus, Slater et al. discloses the step of printing print-specific information on the image prints. Slater et al. does not disclose an order designating a plurality of recipients to receive a print. Sheridan discloses in figure 2 and column 4, lines 48-67, the desire to share image sets with a plurality of recipients for the well known purpose of increasing the pleasure of viewing the images among friends and relatives or increasing the efficiency of distribution of images in a business environment. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide Slater et al. with an order designating a plurality

Art Unit: 2851

of recipients in view of Sheridan. With respect to claim 64, element 509 in figure 5 of Slater et al. is a textual message. With respect to claim 69, figure 8 in Slater et al. discloses recipient-specific information printed on a back of the image print.

Allowable Subject Matter

10. Claims 15-22, and 25- 31 would be allowable subject to filing a proper terminal disclaimer. Claims 2-4, 11-14, 49-51, 58-61, and 65-68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and subject to filing a proper terminal disclaimer. Claims 23 and 24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and subject to filing a proper terminal disclaimer

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

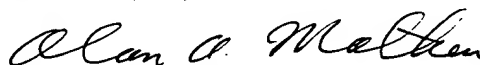
Art Unit: 2851

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan A. Mathews whose telephone number is (703) 308-1706. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on (703) 308-2847. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Alan A. Mathews
Primary Examiner
Art Unit 2851

AAM
January 11, 2003